

**REMARKS/ARGUMENTS**

This amendment is submitted in response to the Office Action dated October 18, 2005. Reconsideration and allowance is requested.

Claims 13, 15-23, 59-61, 63-65 and 67 remain in this application. Claims 1-12, 14, 24-58, 62, 66, and 68-72 were previously canceled.

***Claim Rejection Under 35 USC 112***

In the Office Action, claims 59-61, 63-65 and 67 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement because the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically the Examiner stated:

Claim 59, lines 3-11 "dielectric substrate..., wherein the base portion comprises a flange that contacts the top surface of the ground trace and extends substantially parallel to the surface of the printed circuit board and a plurality of walls that extend substantially orthogonal to a surface of the printed circuit board...removably coupling a top portion of a metallized dielectric substrate shield body to the plurality of walls of the base portion" is not described in the specification (bold and underlined portion).

In response, claims 59 and 67 have been amended to change "metallized dielectric substrate" to "metallized substrate". Support for this amendment can be found throughout the originally filed specification and specifically in paragraph [0062] of the originally filed specification. Although the Applicants believe that the "flange" and the "surface of the printed circuit board," described in claim 59, are adequately described in the figures and specification, claim 59 has been amended to remove references to the "flange" as well as references to the "surface of the printed circuit board."

The Applicants believe that the remainder of claim 59 is disclosed in FIG. 9 and 10A as well as paragraphs [0062] and [0063]. Specifically, the limitation "wherein the base portion contacts the top surface of the ground trace" and the limitation "extends substantially parallel to the top surface of the ground trace" is clearly discernable by looking at FIG. 9 and reading paragraph [0062]. Additionally, the limitation "a plurality of walls that extend substantially orthogonal to the top surface of the ground trace" is also clearly seen in the embodiment of FIG. 9 where the walls of the base portion are shown to be orthogonal to the flat end of the base portion which will contact the ground trace as described in paragraph [0062]. The Applicants believe there is sufficient description in the specification to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. In light of the above amendments and remarks, the Applicants respectfully request that the rejection of claims 59-61, 63-65 and 67 under 35 USC 112 be reconsidered and the claims allowed.

### ***Claim Rejection Under 35 USC 103***

In the Office Action, the Examiner rejected claims 13, 15-17, and 21-23 under 35 USC 103(a), as being unpatentable over Higgins III (U.S. Patent 5,639,989) in view of Nagaike et al. (U.S. Patent 5,945,213). The Applicants respectfully traverse.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaack* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) And MPEP 2143. The Applicants respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

First, no suggestion or motivation for combining these two references has been shown. The mere mentioning of vacuum metallizing a metal layer over plastics in Nagaike is insufficient to establish the motivation to modify Higgins III. The fact that Higgins III and Nagaike can be combined is not sufficient to establish *prima facie* obviousness. In determining whether there is a motivation to combine references, the Examiner must consider the references in their entirety. See MPEP §2141.02.

Applicants disagree with the Examiner's statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of metallizing a first conductive layer of the insulating base coating, as taught by Nagaike et al. on the method of Higgins III so as to protect against disturbing electromagnetic waves and / or radio frequency interference." Since Nagaike clearly states in column 2 lines 32-33 that "it is not easy to form EMI shields over surfaces of plastic jackets," one skilled in the art would not have read Nagaike and thought it was obvious to vacuum metallize a conductive layer over a plastic. Realistically, after reading Nagaike one skilled in the art would think that it is not obvious to vacuum metallize plastics and probably would also think that if he tried vacuum metallizing plastics he would face significant challenges. In short, there is nothing in Nagaike which provides a suggestion for using vacuum metallization with Higgins III.

Moreover, the Nagaike reference appears to teach against modifying Higgins III to include a vacuum metallized layer. Although it is true that in column 2 lines 22-31 Nagaike discloses the step of vacuum metallizing a first conductive layer over the insulating base coating, Nagaike as a whole discourages rather than suggests or motivates using vacuum metallization. If column 2 is read in its entirety it is clear that Nagaike only mentions vacuum metallization so that he can discuss the problems with using it and certainly does not encourage or motive its use.

Methods currently employed to form EMI shields over suitable surfaces of plastic jackets or cases include the application of conductive paints, metal-arc spraying, vacuum metallizing, evaporating, cladding, and deposition of metal layers (by electroplating or electroless plating).

In practice, however, it is not always easy to form EMI shields over surfaces of plastic jackets or cases and the plastic surfaces

have to be given a preliminary treatment in order to ensure positive depositing of the intended EMI shields. However, mechanical pretreatments such as surface roughening may occasionally destroy the plastic surfaces per se.

To avoid this problem, primer paints are applied to form undercoats which, in turn, are overlaid with EMI shields.  
(column 2 lines 26-40)

Since this is the only place in Nagaike where vacuum metallization is mentioned, a person reading the Nagaike reference as a whole would not be motivated to combine the vacuum metallization method described in the single sentence in the background with Higgins III to come to the Applicants claimed invention. Furthermore, Nagaike's entire disclosure talks about the problems with depositing metal layers onto plastics and encourages using a paint composition applied to the plastic to form an undercoat before the metal layer is electropolished onto it. Realistically, Nagaike appears to teach away from using vacuum metallization rather than suggesting or motivating its use.

Finally there is no reasonable expectation of success. Nagaike discusses the problems with using vacuum metallization to coat plastics and proposes that a solution would be to coat the plastics with a primer. Therefore, one skilled in the art reading Nagaike would not expect success.

Since all three criteria enumerated in *In re Vaeck* have not been shown, prima facie obviousness has not been established. Therefore, the Applicants believe that independent claim 13 is allowable over the cited references. Dependent claims 15-17 and 21-23 should be allowable at least for depending from allowable independent claim 13. Additionally, the dependent claims further provide novel aspects that are not described or suggested by the cited references.

In the Office Action, the Examiner rejected claim 15 under 35 USC 103(a), as being unpatentable over Higgins III/Nagaike et al. as applied to claim 13 above, and further in view of DiLeo (U.S. Patent 5,968,600). The Examiner argued that DiLeo teaches the step of maintaining a temperature of the electronic component and insulating base coating below approximately 200 degree C during vacuum metallizing (col. 4 lines 36-40) and that one skilled

in the art would have combined DiLeo with Higgins III/Nagaike so as to promote good adhesion to a substrate without distorting the substrate. The Applicants respectfully disagree. In column 4 lines 36-40 DiLeo teaches:

Once the conductive film coating is applied to a substrate, it is cured at room temperature for seven days, or force cured in an oven with the temperature set from 125.degree. F.-400.degree. F. for a time sufficient enough to provide for an accelerated cure and promote good adhesion to a substrate, without distorting the substrate.

Clearly DiLeo is referring to curing a substrate along with the conductive film after the film has been deposited and not maintaining a temperature of the electronic component and insulating base coating below approximately 200°C during vacuum metallizing. These processes are completely different and the temperature range mentioned of the curing process has nothing to do with a temperature range of the vacuum metallization deposition process. Therefore, the Applicants respectfully request that the Examiner reconsider his rejection of claim 15 for this reason. Additionally, claim 15 is patentable because it depends from claim 13 which is patentably distinct over the prior art for the reasons given above.

In the Office Action, the Examiner rejected claims 18 and 19 under 35 USC 103(a), as being unpatentable over Higgins III/Nagaike et al. as applied to claim 13 above, and further in view of Askew (U.S. Patent 5,350,951). Also, the Examiner rejected claim 20 under 35 USC 103(a), as being unpatentable over Higgins III/Nagaike et al. as applied to claim 13 above, and further in view of Gabower. Since claims 18, 19, and 20 depend from claim 13, which is patentably distinct over the prior art for the reasons given above, claims 18, 19, and 20 are also patentable.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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